Supreme Court, U.S.
FILED
DEC 29 1989
JOSEPH F. SPANIOL, JR.
CLERK

No. 89-918

In the

Supreme Court of the United States

October Term, 1989

THE STATE OF TEXAS,

Petitioner,

vs.

WEST PUBLISHING COMPANY,

Respondent.

On Petition For A Writ Of Certiorari To The
United States Court of Appeals
For The Fifth Circuit

BRIEF IN OPPOSITION

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December 29, 1989

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QUESTIONS PRESENTED FOR REVIEW

The Petitioner State of Texas sought a declaratory judgment that the Respondent West Publishing Company's copyrights in its arrangements of Texas statutes were invalid. The U.S. District Court for the Western District of Texas dismissed the Complaint for lack of subject matter jurisdiction on the ground that the State cannot seek judicial invalidation of West's copyrights in the absence of an actual controversy between the parties. The Fifth Circuit Court of Appeals affirmed that dismissal.

The questions presented are:

1. Whether the District Court and the Fifth Circuit correctly held that a federal court does not have subject matter jurisdiction over a declaratory judgment action lacking an actual controversy between the parties.

2. Whether the District Court and the Fifth Circuit correctly held that no actual controversy exists between the State of Texas and West Publishing Company with respect to West's copyrights in its arrangements of Texas statutes.

3. Whether the District Court and the Fifth Circuit correctly held that no actual controversy exists with respect to the State of Texas' secondary claims against West Publishing Company that were dependent upon a prior finding on the validity of West's copyrights in its arrangements of Texas statutes.

STATEMENT OF CORPORATE AFFILIATIONS PURSUANT TO RULE 28.1

Respondent West Publishing Company is a privately held corporation organized under the laws of the State of Minnesota. It has no parent company or affiliates. The Foundation Press, Inc. is a subsidiary of West Publishing Company which is not wholly owned.

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For The Fifth Circuit

BRIEF IN OPPOSITION

West Publishing Company ("West") opposes the petition for a writ of certiorari to review the September 5, 1989 judgment of the United States Court of Appeals for the Fifth Circuit affirming the dismissal of this action by the District Court.

STATUTE INVOLVED

The Declaratory Judgment Act provides that:

> (a) *In a case of actual controversy within its jurisdiction*...any court of the United States, upon the filing of an appropriate pleading, may declare the rights and other legal relations of any interested party seeking such declaration, whether or not further relief is or could be sought....

28 U.S.C. §2201(a) (emphasis added).

STATEMENT OF THE CASE

A. Procedural History

The State of Texas ("the State"), through its Attorney General Jim Mattox, filed suit against West on September 28, 1987 , in the United States District Court for the Western District of Texas ("the District Court"). The State sought a declaratory judgment that West's copyrights in its arrangements of Texas statutes were invalid. West moved to dismiss the State's Complaint for lack of subject matter jurisdiction.

By Order dated January 13, 1988, the Honorable Walter S. Smith, Jr. dismissed the State's Complaint in its entirety, holding that no actual controversy existed between the State and West and that the District Court therefore had no subject matter jurisdiction over the case.

On appeal, the Fifth Circuit[1] concluded that there was no real and reasonable apprehension of litigation by the State and no evidence that West had engaged in a course of conduct that brought it into adversarial conflict with the State. *State of Texas v. West Pub. Co.*, 882 F.2d 171, 175 (5th Cir. 1989) [Pet. App. A at A-6]. The Fifth Circuit affirmed the dismissal of the Complaint based on the well settled precedent of *Windsurfing International, Inc. v. AMF, Inc.*, 828 F.2d 755 (Fed. Cir. 1987), and earlier cases from the Federal Circuit Court of Appeals that govern the extent of declaratory relief available to an intellectual property plaintiff.

[1]The panel consisted of Senior Circuit Judge John Minor Wisdom and Circuit Judges William L. Garwood and E. Grady Jolly.

B. Factual Background

Since 1914, West and its predecessor, Vernon Law Book Company, have collected, edited, compiled, arranged and published a series of volumes containing Texas statutory law, now known as *Vernon's Annotated Revised Civil Statutes of the State of Texas* ("*Vernon's*"). West claims copyright protection in those portions of *Vernon's* which are original to it, including the arrangements of the compilations expressed by West-created article designations and headings ("the *Vernon's* arrangements"). These arrangements, together with West's copyrighted annotations, tables, indices and historical notes, provide legal consumers with an efficient and organized source of Texas statutory law. West, however, has never claimed that *Vernon's* represents an "official" source of Texas statutes.[2]

In 1925, the Texas Legislature reorganized all existing Texas civil statutes into a two-volume set known as the "Revised Civil Statutes" (the "1925 Revision"). These statutes were divided by title, such as "Workmen's Compensation law," and then further subdivided by article numbers supplied by the Legislature. The classification scheme devised by the Legislature in 1925, however, left no room for expansion beyond the laws contained in the 1925 Revision, or for the addition of any new laws. Even new laws enacted by the 1925 Legislature were not included in the two-volume 1925 Revision. Except for amendments and additions to laws contained therein, the Legislature's arrangement of statutes within the two-volume 1925 Revision was a finite and completed work at the time of the initial publication. The State has never published an updated or expanded version of the 1925 Revision.

[2]In *Johnson v. City of Fort Worth*, 774 S.W. 2d 653 (Texas 1989), the Texas Supreme Court found that West's statutory arrangement "cannot have the force of law." 774 S.W. 2d at 655. In that case, a defendant attempted unsuccessfully to rely upon the placement by West within *Vernon's* of a particular statute. Thus, the State, in its alleged *parens patriae* capacity, claims that the need for Texans to have access to *Vernon's* arrangements raises a controversy of Constitutional magnitude [Pet. at 10] at the same time as the Texas Supreme Court is warning Texans not to rely on that arrangement. The irony of the State's position was not lost on the Fifth Circuit, which cited *Johnson* and noted this inconsistency. 882 F.2d at 173-74 n.2 [Pet. App. A at A-2].

Since the 1925 statutory reorganization, the Texas Legislature has enacted numerous changes and additions to statutes contained in the 1925 Revision, as well as new provisions not contained within that set. When the Legislature amends a statute that originally appeared in the 1925 Revision, it generally refers by article designation to the statute in question. The Legislature likewise refers to the 1925 article designation when it enacts additional components to an original statute within the 1925 Revision.

Most enactments after 1925, however, did not mechanically "fit" into the 1925 organizational scheme because of the limited scope of the 1925 Revision. For that very reason, after 1925 the Legislature could not, in most instances, refer to new enactments according to any existing Revised Civil Statute article number without creating a new designation. With few exceptions, however, the Legislature did not create any new article designations. Instead, the Legislature has generally referred to new enactments solely by legislative session and chapter designations. In addition, the Legislature has always included a parenthetical cite to the *Vernon's* designation for existing statutes not contained in the 1925 Revision.

West continued to compile and publish the Texas statutes after the 1925 Revision was printed. When subsequent Texas legislatures failed to devise a scheme for designating new statutes that did not fit within the 1925 Revision, West began creating original arrangements of those enactments. West's original arrangements of Texas civil statutes are reflected in *Vernon's*. Beginning in 1925, whenever the Legislature enacted a new statute, or amended an existing statute which was not part of the 1925 Revision, West arranged the new statute within its *Vernon's* compilations and created an appropriate article designation and heading for that statute.

Essentially, West's arranging work involves reviewing the contents of a newly enacted statute, determining the most appropriate location for the statute within *Vernon's* compilations, and selecting the most appropriate combination of numerals and letters which sensibly expresses the location. West's editorial staff must perform this arranging process for each new statute enacted by the Texas Legislature that does not fit into the 1925 Revision. West's arranging work results in an article designation and, in some cases, a heading, for each

new Texas statute, and thereby permits legal researchers to locate a particular statute within *Vernon's* compilations and refer to and express that location to others seeking to find the statute.

West's original—and copyrighted—statutory arrangements therefore include the editorially determined (i) selection of the most appropriate title in which to include a particular statutory enactment; (ii) selection of an appropriate chapter within the selected title; (iii) selection of the most appropriate location within the selected chapter in which to classify the statute; and, (iv) creation and assignment of an article designation to express such location, together with appropriate headings.

In 1963, the Legislature again started a major revision of the Texas statutory scheme, its first since 1925. The Legislature began formulating a new organization for Texas laws by grouping various statutes into new, topically divided "Codes." West began publishing the Codes in a separate set, *Vernon's Texas Codes Annotated*. With rare exceptions, all of the statutes thus far codified have been arranged by the Legislature, and the section designations expressing those arrangements have been created by the Legislature. West has never claimed a copyright in the arrangements of *these* Codes. According to the State's Complaint filed in September of 1987, the codification program was at that time approximately one-half completed. Complaint at Par. 10. West's editorial staff therefore must continue to perform original arrangements and create article designations and headings for all statutory enactments that do not fit into completed portions of the Codes. West does claim a copyright in *this* original work.

Contrary to the State's claim of "intermingling" of legislatively created designations and West-created designations, the Texas Legislature has consistently distinguished between article numbers originating in, or added to, the 1925 Revision, and article designations originating with West as a result of West's arranging work. Whenever the Legislature amends a statute that originally appeared in the 1925 Revision or was subsequently added to that Revision by the Legislature, the enactment will refer or cite to the article designation in the 1925 Revision. When, however, the Legislature amends a statute that is not a part of the 1925 Revision, the enactment is referenced by a legislative session and chapter number, the

only official citation, followed by a parenthetical cite to the existing *Vernon's* article designation.

In addition to publishing the hard-bound *Vernon's* set and cumulative pocket parts, West publishes, each biennium, its soft-bound legislative session pamphlet series entitled "*Vernon's Texas Session Law Service.*" These volumes consist of enrolled bills as enacted by the Legislature, with references to either the official 1925 Revised Civil Statutes (noting the article designation as supplied by the 1925 Legislature or amendments thereto), or to the non-official, West-created article designation (noting the legislative session year and the chapter number or popular name of the Act, and a parenthetical cite to the *Vernon's* article designation). West's soft-bound session laws are published and distributed periodically throughout each legislative session, and the entire set is generally completed and distributed by the month of August. The soft-bound session laws also contain notes provided by West, as a service to its customers, referencing where the new laws or amendments will appear in West's copyrighted *Vernon's* compilations.

Since 1941, with the exception of 1985, West has also printed the *"General and Special Laws of Texas,"* a hardbound version of the session laws that is an official publication of the Texas Secretary of State. The printing bid for this official version of the session laws was awarded to one of West's competitors, the Bancroft-Whitney Publishing Company, for the 1985 (69th) Legislative Session. Bancroft-Whitney, as West had done since 1941, simply printed the laws in chronological order by their approval or filing dates and in numerical order by chapter number. In printing the enrolled bills ("enactments"), Bancroft-Whitney also followed the meticulous distinction drawn by the Legislature between official article designations found in the 1925 Revision (reference to 1925 Civil Statutes and subsequent official amendments by citing "Article _____, Revised Statutes") and West-created article designations (reference to the legislature session year, Chapter number, and a parenthetical cite to *Vernon's.*) West has never entered into a contract with the State of Texas to publish a complete revised edition of the 1925 Revision, and has never been under contract

with the State to arrange and publish any of the *Vernon's* compilations.[3]

In sum, West claims a copyright in its arrangements of Texas statutes, arrangements expressed through the use of article designations and headings for each statute indicating the location and placement of a particular legislative enactment within West's *Vernon's* compilations. West's copyrights have never been previously questioned by the State, and in fact have been carefully noted and consistently recognized by the Legislature itself. West, a private entity, is certainly under no obligation, whether "official" or otherwise, to continue to arrange the laws in its own editorial judgment so they fit within the original 1925 framework. Conversely, no publisher or competitor -- nor the State of Texas, as the Fifth Circuit held -is prevented from publishing its own arrangements of Texas statutes.

REASONS FOR DENYING THE WRIT

Contrary to the State's assertion, there is no dispute over *"ownership"* of, or *"access"* to, any portion of Texas statutory law. The State's petition mistakenly treats the decisions below as if they addressed the merits of the State's claim that West cannot copyright its arrangement of *Vernon's*. The petition then asserts a conflict between the Fifth Circuit's decision and decisions addressing the scope of copyright protection for compilations of statutes, administrative codes or case reports.

The question before this Court, however, is *not* the scope of copyright protection for *Vernon's*. Rather, it is whether the Fifth Circuit correctly determined that the District Court lacked jurisdiction to render a declaratory judgment because no actual controversy exists between West and the State.

[3]On page 6 of its Petition, the State claims, as it unsuccessfuly did below, that "West is Texas' agent pursuant to a series of contracts entered into between them." In fact, the only "contract" between these parties is and was a *printing* contract to print the session laws in chronological and numerical order by date of enactment. Those contracts have absolutely no bearing on West's original arrangements that appear in *Vernon's*, arrangements that are created regardless of whether West is awarded the biennial printing contract for the session laws.

As this Court stated in *Maryland Casualty Co. v. Pacific Coal & Oil Co.*, 312 U.S. 270, 272 (1941):

> The question is whether petitioner's allegations are sufficient to entitle it to the declaratory relief prayed in its complaint. This raises the question whether there is an 'actual controversy' within the meaning of the Declaratory Judgment Act, ... since the District Court is without power to grant declaratory relief unless such controversy exists.

312 U.S. at 272 (citations omitted).

The State does not contest the basic holding of *Maryland Casualty* or the Fifth Circuit's decision below that, absent a finding of an actual controversy, the District Court has no subject matter jurisdiction to issue a declaratory judgment.[4] Instead, the State seeks to reargue before this Court the facts upon which the courts below based their decisions. That is not a reason for this Court to grant a writ of certiorari. *United States v. Johnston*, 268 U.S. 220, 227 (1925); *Texas v. Mead*, 465 U.S. 1041 (1984).

I.
THE FIFTH CIRCUIT'S DECISION BREAKS NO NEW GROUND AND DOES NOT CREATE A CONFLICT IN THE CIRCUITS

Both the Fifth Circuit and the District Court begin their discussions with the same quote from *Middle South Energy, Inc. v. City of New Orleans*, 800 F.2d 488, 490 (5th Cir. 1986), namely, that a "federal court may not issue a declaratory judgment unless

[4]The petition's perfunctory discussion of the scope of the Declaratory Judgment Act [Pet. at 13-14] begs the question by assuming there is a "dispute" between West and the State. The absence of any dispute,of course, formed the entire basis for the Fifth Circuit's decision. This Court has clearly stated that, "The operation of the Declaratory Judgment Act is procedural only .... Congress enlarged the range of remedies available in the federal court, but it did not extend their jurisdiction." *Skelly Oil Co. v. Phillips Petroleum Co.*, 339 U.S. 667, 671 (1950)(citations omitted). None of the cases or treatises cited in the petition is in conflict with this Court's determinations in *Maryland Casualty* and *Skelly Oil* that there must be an actual controversy before there can be a declaratory judgment and that the Declaratory Judgment Act did not enlarge the scope of an actual controversy.

there exists an 'actual controversy,' i.e., there must be a substantial controversy of sufficient immediacy and reality between parties having adverse legal interests." 882 F.2d at 175 [Pet. App. A at A-5]; *State of Texas v. West Pub. Co.*, 681 F. Supp. 1228, 1229 (W.D. Tex. 1988) [Pet. App. B at B-2].

Both the Fifth Circuit and the District Court determined that the precedent most applicable, given the State's intention to challenge West's copyrights, consisted of the recent and uniform line of intellectual property cases from the Federal Circuit discussing the case or controversy question. Thus, both courts relied upon *Windsurfing International, Inc. v. AMF, Inc.*, 828 F.2d 755 (Fed. Cir. 1987) (involving patents); *Goodyear Tire & Rubber v. Releasomers*, 824 F.2d 953 (Fed. Cir. 1987) (same); *International Medical Prosthetics Research Assocs. v. Gore Enters. Holdings, Inc.*, 787 F.2d 572 (Fed. Cir. 1986) (same); and *Indium Corp. v. Semi-Alloys, Inc.*, 781 F.2d 879 (Fed. Cir. 1985), *cert. denied*, 479 U.S. 820 (1986) (involving trademarks).

Accordingly, the courts below adopted, without modification or expansion, the Federal Circuit's standard that "an 'actual controversy' exists in an intellectual property case when both prongs of a two-pronged test are satisfied -- (1) when the declaratory plaintiff has a real and reasonable apprehension of litigation and (2) when the declaratory plaintiff has engaged in a course of conduct that brings it into adversarial conflict with the declaratory defendant." 882 F.2d at 175 [Pet. App. A at A-5]; 688 F. Supp. at 1229 [Pet. App. B at B- 2]. That standard is consistent with this Court's holding in *Maryland Casualty* and other decisions of this Court addressing the case or controversy requirement of the Declaratory Judgment Act. *See Babbitt v. United Farm Workers National Union*, 442 U.S. 289, 297-98 (1979); *Railway Mail Association v. Corsi*, 326 U.S. 88, 93 (1945).

Case or controversy decisions involving intellectual property in other lower courts have applied tests that are entirely consistent with this standard. *See, Goya Foods, Inc. v. Tropicana Products, Inc.*, 666 F. Supp. 585, 588 (S.D.N.Y. 1987), *reversed on other grounds*, 846 F.2d 848 (2nd Cir. 1988) (involving trademarks); *Cilco, Inc. v. Precision-Cosmet, Inc.*, 624 F. Supp. 49, 53 (D. Minn. 1985) (involving patents); *Crown Drug Co. v. Revlon, Inc.*, 703 F.2d 240, 243 (7th Cir. 1983) (trademarks);

Polaroid v. Berkey Photo, Inc., 425 F. Supp. 605, 609 (D. Del. 1976) (patents); *Wembley, Inc. v. Superba Cravats, Inc.*, 315 F.2d 87, 90 (2nd Cir. 1963) (trademarks).

Therefore, the State cannot and does not assert that there is any conflict, let alone one worthy of this Court's attention, with respect to the standard to be applied for determining whether an actual controversy exists in an intellectual property case. Nor is it likely, given the Federal Ciruit's preeminence in intellectual property matters and the reasoned decisions of the courts below in adopting that standard, that there ever will be any conflict among the Courts of Appeal with respect to this question.

The petition's attempt to construct a conflict between the Fifth Circuit's decision and cases discussing the scope of copyright protection for statutory compilations ignores the limited scope of the Fifth Circuit's decision. By finding no actual controversy, the Fifth Circuit precluded itself from addressing the merits of the State's position. As a result, there can be no conflict between the Fifth Circuit decision and decisions addressing the scope of copyright protection for statutory compilations. The petition's discussion of cases addressing that issue is wholly unnecessary and provides no support for a writ of certiorari.[5]

[5]None of the statutory copyright cases discussed by the State was concerned with the existence of a case or controversy between the parties. That is because, in each of those cases, the parties were competing publishers who either were or were actively trying to publish the copyrighted work. Thus, *Wheaton v. Peters*, 33 U.S. 591 (1834); *Banks v. Manchester*, 128 U.S. 244 (1888); and *Callaghan v. Myers*, 128 U.S. 617 (1888) involved competing publishers of U.S. Supreme Court, Ohio Supreme Court and Illinois Supreme Court case reports, respectively. In *Building Officials & Codes Adm. v. Code Technology, Inc.*, 628 F.2d 730 (1st Cir. 1980), the parties were competing publishers of legislatively adopted building codes. Those cases are completely consistent with the Fifth Circuit's analysis of when an actual controversy arises in a copyright case. More importantly, those decisions directly controvert the argument of the State that it is the only party that will ever be in a position to challenge West's copyrights. *See* Pet. at 14-15.

II.
THE FIFTH CIRCUIT PROPERLY APPLIED THE STANDARD FOR DETERMINING WHETHER AN ACTUAL CONTROVERSY EXISTS

The Fifth Circuit found that neither prong of the test for the existence of an actual controversy had been met by the factual record in this case. 882 F.2d at 175 [Pet. App. A at A-6]. Accordingly, the Fifth Circuit held that it lacked subject matter jurisdiction to issue a declaratory judgment.

The State argues in its petition that its "interest in returning its statutory law to the public domain is sufficiently adverse to West's putative copyright interest to present an actual controversy." Pet. at i and 6. However, both courts below found the State's "interest" at best speculative and at heart illusory.

> There is no evidence that Texas has in the past, is currently, or intends in the future to engage in any commercial publishing of Vernon's Texas' limited noncommercial publication of pamphlets for its own intragovernmental use is not an activity that is legally adverse to West. On the contrary, the record reveals that this limited noncommercial publishing has occurred for years without any conflict of any kind between the parties. Texas is simply not a competitor of West and it is not engaged in any publishing activity that places it in adversarial conflict with West.
>
> Texas cannot satisfy the adversarial conflict requirement by stating that one day *it might* want to compete with West in the commercial publication of the Vernon's arrangement. This imaginary conflict is even more remote than the 'conflicts' rejected in the case law where the parties were at least business competitors.

882 F.2d at 175-76 (emphasis in original) [Pet. App. A at A-6].

As the District Court also found, the complaint and the record are devoid of any evidence that there existed a controversy between West and the State:

> The State of Texas may not find it appealing that West has claimed this copyright [in the *Vernon's* arrangement], but this is not enough to create a dispute which is ripe for the federal courts. There can be no actual controversy unless West does something that gives the State a reasonable apprehension of litigation. Nowhere in its Complaint or other pleadings does the State allege that West has actually threatened to take *any action* against the State of Texas to protect their claimed copyright or even that West has ever accused the State of infringing its claimed copyright. Nowhere in its pleadings does the State allege that it intends to infringe on West's copyright. Nowhere does the State allege that it has engaged in or intends to engage in a course of conduct which either brings it or will bring it into an adversarial relationship with West.
>
> In sum, the record is simply devoid of any evidence or allegations which would suffice to meet the State's burden of establishing the existence of an actual controversy. The *only* effect that granting the requested relief would have would be to invalidate a claimed copyright. For the Court to issue an opinion on the validity of this claimed copyright under these circumstances would be for the Court to issue an advisory opinion which is beyond the Court's jurisdiction.

681 F. Supp. at 1231 (emphasis in original) [Pet. App. B at B-5].

The petition seeks to circumvent the findings of the courts below by arguing the principle that "all law must remain in the public domain and is not subject to copyright." Pet. at 7. However, as both courts below expressly noted, West has never disagreed with that principle. "West claims no interest in the

text of the Texas statutes or in Texas law itself." 681 F. Supp. at 1231 [Pet. App. B at B-6]. *See, also*, 882 F.2d at 177 [Pet. App. A at A-9] ("Also, over half of Texas statutory law has already been arranged under the 1963 recodification and West does not claim a copyright in this arrangement.").

The petition unconvincingly tries to elevate its "public domain" theory to the level of a justiciable controversy by asserting that West has violated "public policy" by claiming a copyright in its own arrangements of *Vernon's*. Pet. at 9. That argument, however, ignores the well-settled precedent of this Court that abstract public policy arguments do not rise to the level of a case or controversy for purposes of jurisdiction. *Simon v. Eastern Kentucky Welfare Rights Organization*, 426 U. S. 26, 40 (1976) ("Our decisions make clear that an organization's abstract concern with a subject that could be affected by adjudication does not substitute for the concrete injury required by Art. III."); *Sierra Club v. Morton*, 405 U.S. 727, 741 (1972) (same).

Nonetheless, the State continues to argue that certain "due process rights" of Texas residents are jeopardized as long as West is permitted to hold a copyright in its original *Vernon's* arrangements. Having "access" to *Vernon's*, however, constitutes much less than a "constitutional" right, according to the Texas Supreme Court in *Johnson v. City of Fort Worth*, 774 S.W.2d 653 (Texas 1989). In that case, the Texas Supreme Court held that because the "West-supplied article number" at issue was "unofficial, however, it cannot have the force of law." 774 S.W.2d at 655.

The *Johnson* decision, affirming the unofficial status of West's copyrighted arrangements in *Vernon's*, is entirely consistent with the Fifth Circuit's and the District Court's holdings in this case. Nothing West has ever done or could ever do would *deny* Texans their rightful access to Texas law, given the State's own ability to publish its statutes:

> The State is basically concerned that it is 'gambling' that West will do or not do certain things in the future. While this may not be what the State would consider an ideal situation, the State essentially admits that West has not done or threatened to do anything *yet*. The State is asking for an advisory

> opinion so that it won't have to 'gamble.' This is not a proper function of the federal courts.
>
> As to the substance of this 'gamble,' West claims no interest in the text of the Texas statutes or in Texas law itself. Thus, the State cannot claim to be 'gambling' on the access of its citizens to their law in any absolute sense. The State cannot claim any apprehension *at all* in simply publishing its laws in any of the myriad manners available with the exception of the single West editorial arrangement. Nor can the State 'gamble' tnat West will continue to publish because the State could not obtain injunctive relief to force West to publish if it did not desire to do so.

681 F. Supp. at 1231 (emphasis in original) [Pet. App. B at B-6].

The Fifth Circuit agreed with this finding of the District Court and held that "Texas residents are not being deprived of any due process right they could conceivably have to access Texas laws." 882 F.2d at 177 [Pet. App. A at A-9].

The State grudgingly concedes, as it must, the accuracy of the Fifth Circuit's conclusion. At page 10 of the petition, the State admits that, "the Fifth Circuit's statement that due process rights are not implicated because there is access to the General and Special session laws is correct, but only in an absolute sense." The State then attempts to argue that there is nonetheless a controversy between it and West. The result, however, is to demonstrate precisely why the Fifth Circuit found that this case "smacks too much of the hypothetical and contingent." 882 F.2d at 176 [Pet. App. A at A-7]. Indeed, all the State can argue is that:

> *If* tomorrow West invoked its right as a copyright owner to refuse to publish Texas statutory law and [if West] prevented anyone else from publishing it in its current form, citizens arguably have access to the *actual text* of statutory law through the Special and General session laws. ["General and Special Laws of Texas"].

Pet. at 10 (emphasis and parentheses added). It could not be more clear, using the State's own example, that before there can be a controversy between West and the State, two hypothetical events must transpire – West must cease publishing Texas statutory law and West must seek to prevent the State from doing so. Even then, the State concedes that Texas residents *still* would have access to the laws of Texas, though it seeks to cloud that concession by tacking on the meaningless limitation: "but only in an absolute sense." Pet. at 10.

By listing the string of hypothetical events arguably sufficient to bring the relationship between the State and West into conflict, the State acknowledges that there is no current controversy.[6] Without a controversy, there is no basis for this Court to grant a writ of certiorari.

[6]The State's extensive reliance in the petition on Patterson & Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 U.C.L.A. L.Rev. 719 (1989) is similarly misplaced. The authors of that article disagree with the merits of the decision in *West Publishing Company v. Mead Data Central, Inc.*, 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070 (1987). By inference, therefore, that article suggests that the authors would find that a case or controversy may arise if West were to take the hypothetical steps of ceasing to publish case reports or statutes and attempting to stop others from doing so. However, nowhere is that position stated in the article, the focus of which is, as the title suggests, on the *scope* of copyright protection for law reports and statutory compilations. Since the scope of copyright protection is not an appropriate question for certiorari in this case, that article is of no relevance to the Court's consideration of the petition.

III.
THE STATE'S FAILURE TO ESTABLISH AN ACTUAL CONTROVERSY WITH RESPECT TO THE PRIMARY CLAIM PRECLUDED SEPARATE CONSIDERATION OF THE STATE'S DEPENDENT SECONDARY CLAIMS

The Fifth Circuit recognized that, in the absence of a case or controversy with respect to the primary claim of the State that the *Vernon's* arrangement is in the public domain, there could be no separate jurisdiction to address the State's secondary claims. Although those secondary claims were couched in terms of joint ownership and work-for-hire, the Fifth Circuit found that they were in reality just another form of challenge to the validity of West's copyrights. "These claims are so intertwined with the primary claim that they expressly depend upon the prior adjudication of the validity of West's copyright in *Vernon's*." 882 F.2d at 177 [Pet. App. A at A-9].

Simply stated, the Fifth Circuit held that subject matter jurisdiction to issue declaratory relief on secondary claims asserting traditional intellectual property defenses stands or falls with the court's jurisdiction to decide the primary "invalidity" issue. The petition does not challenge that conclusion with any precedent or reasoned analysis. Instead, the petition concedes that the State has no real interest in litigating the secondary claims independently from its main claim that West's copyrights are invalid:

> Although Texas wishes to gain the benefit of any bargain it struck with West, its primary goal is to ensure access to the law [by claiming West's copyrights invalid]. To ensure that access, Texas filed suit.

Pet. at 16. The Fifth Circuit's conclusion that the State did not, therefore, have a case or controversy with West regarding these secondary claims is correct.

As an apt demonstration of this holding, the Fifth Circuit posited the type of "order" it would be forced to issue if it ruled on the secondary claims alone:

> The purely hypothetical and contingent nature of Texas' joint ownership claim, absent a finding of copyright validity, is illustrated by the judgment we would have to render if we decided Texas' secondary claim. Such a judgment would state something to the effect that 'Texas is [is not] a joint owner with West of any copyright West holds in Vernon's *if* West holds any such copyright.'

882 F.2d at 177, n.10 (emphasis in original) [Pet. App. A at A-10].

The Fifth Circuit concluded that, "Texas cannot bootstrap itself into a decision on the validity claim by asserting secondary claims that necessarily depend on the resolution of the primary claim. ... Such pleading stratagems only serve to undermine the actual controversy requirements of Article III of the Constitution as it applies to declaratory judgments." *Id.* (citations omitted). That position is legally correct, is not called into question by the State's petition and is not in conflict with any precedent.[7]

IV.
THE STATE HAS NOT BEEN DENIED ACCESS TO THE COURTS AND NO PARTY HAS BEEN PRECLUDED FROM CHALLENGING WEST'S COPYRIGHTS SHOULD AN ACTUAL CONTROVERSY EVER DEVELOP

The State argues that certiorari must be granted in order to extricate the State from a "Catch 22" predicament. According to the petition, the Fifth Circuit decision supposedly left Texas with "no forum to vindicate the due process rights of its citizens ... because only a commercial publisher can [now] seek an invalidation of West's copyrights." Pet. at 14. Neither aspect of this alleged "Catch 22" appears anywhere in the actual decision of the Fifth Circuit.

[7] As succinctly stated in *Cilco, Inc. v. Precision-Cosmet, Inc.*, 624 F. Supp. 49, 53 (D. Minn. 1985), "since the court has determined that Count I fails to state a case or controversy between these litigants, and, since Count II is dependent on the resolution of Count I, Count II must also be dismissed." *See, also, Windsurfing International, Inc. v. AMF, Inc.*, 828 F.2d 755, 759 (Fed. Cir. 1987); *Techniques, Inc. v. Rohn*, 592 F. Supp. 1195, 1198 (S.D.N.Y. 1984).

The Fifth Circuit in fact recognized that West and the State *could* have a controversy over West's copyrights. As discussed earlier, the Fifth Circuit went so far as to enunciate the hypothetical steps that would be required for that controversy to arise, namely, that the State engage in publishing activity that places it in adversarial conflict with West *and* that West takes active steps to stop the State. 882 F.2d at 175-76 [Pet. App. A at A-5 and A-6].

Equally meritless is the State's contention that private publishers could never have an interest in challenging West's copyrights. As the Fifth Circuit noted, the same copyrights that the State seeks to challenge currently are being challenged by Bancroft-Whitney, a private publisher that sought to distribute *Vernon's* arrangements through an electronic format. 882 F.2d at 174 [Pet. App. A at A-4].

Therefore, it is beyond dispute that nothing in the Fifth Circuit's decision limits or affects in any way the right of either the State or a private publisher to challenge West's copyrights, should an actual controversy ever develop. It would be an enormous waste of this Court's time to grant certiorari simply to clarify for the State what is clear on the face of the Fifth Circuit decision.

V.
THE ISSUES RAISED BY THE STATE'S PETITION DO NOT WARRANT THIS COURT'S ATTENTION

One of the considerations established by this Court governing review on certiorari is whether "a federal court of appeals has decided an important question of federal law which has not been, but should be, settled by this Court ..." Sup. Ct. R. 17.1(c). Importance is measured by the impact of the decision on the public "as distinguished from that of the parties." *Rice v. Sioux City Memorial Park Cemetery*, 349 U.S. 70, 79 (1955).

West's ownership of its copyrighted arrangements in

Vernon's is of great value to West, but it is insignificant to the public at large.[8] Even the State concedes that no one is being denied access to Texas law, and the Fifth Circuit found that it is unlikely that anyone ever will be. 882 F.2d at 177 [Pet. App. A at A-9]. The State's 1963 recodification already has rendered more than half of the *Vernon's* arrangements of historical interest only, and the percentage of Texas law encompassed by the recodification is growing with every legislative session. Moreover, given the absence of any controversy between the State and West over the State's use of the *Vernon's* arrangements, the question of whether those arrangements are subject to a valid copyright is of no consequence to the State or to the citizens of Texas.

[8]The situation is similar to that faced by this Court in reviewing the petition for a writ of certiorari in *West Publishing Co. v. Mead Data Central, Inc.*, 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070 (1987), a case involving the scope of West's copyrights in its National Reporter System® publications. Without knowing the reasons for this Court's denial of certiorari in that case, it is likely that one of the reasons was the recognition that the public's stake or interest in the dispute was nonexistent.

CONCLUSION

Based on the foregoing, the petition for a writ of certiorari should be denied.

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December 29, 1989